

REMARKS

Claims 11 to 30 are now pending. Applicants respectfully request reconsideration of the present application in view of this response.

Claims 11, 24 and 30 have been rewritten above. Underlining indicates additions and strikeouts indicate deletions. No new matter has been added.

35 U.S.C. § 102(b) - Atalla reference

Claims 11 to 13, 15, 16, 18, 19, 22, 23, 25, 27 and 29 were rejected under 35 U.S.C. § 102(b) as anticipated by Atalla et al., U.S. Patent No. 5,319,710.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim limitations be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). In particular, it is respectfully submitted that the reference relied upon would not enable a person having ordinary skill in the art to practice the subject matter of the claims as presented.

The “Atalla” reference purportedly concerns combining and managing personal verification and message authentication encryptions for network transmission, and refers to providing a method and an arrangement for integrating the encryption keys associated with the personal identification number (“PIN”) and message authentication code (“MAC”) to assure that the codes are sufficiently interrelated and that alteration of one such code will adversely affect the other such code and inhibit message authentication in the network. (See col. 2, lines 10-16). The “Atalla” reference recites that by using one session key to encrypt the PIN along with the MAC, a random number, the message, and the sequence number which are also encrypted with the PIN such that re-encryption thereof in the transmission from location to location, or node to node over a network is greatly facilitated and validated at each node. (See col. 2, lines 21-28). The “Atalla” reference further refers to portions of the random number being selected for use as the Acknowledgment or Non-Acknowledgment return codes which can be securely returned and which can then only be used once to unambiguously validate the returned code only at the originating node in the network. (See col. 2, lines 28-33).

In contrast, amended claim 11 recites a method for transmitting signals between a transmitter and a receiver including: calculating data as a function of a secret key using at least one cryptographic algorithm in a calculation phase; and calculating authentication

tokens for the signals as a function of the data in a communication phase so as to authenticate both the signals and a transmission sequence of the signals, wherein the signals received by the receiver from the transmitter are accepted as authentic if a transmitted authentication token that is received by the receiver matches the authentication token calculated by the receiver, the authentication token calculated by the receiver completable before actual transmission of the signals.

Accordingly, the “Atalla” reference does not identically disclose (as it must for anticipation) or even suggest at least the feature of calculating an authentication token *as a function of the data in the communication phase* to authenticate both the signals and transmission sequence of the signals, *wherein the signals received by the receiver from the transmitter are accepted as authentic if a transmitted authentication token that is received by the receiver matches the authentication token calculated by the receiver, the authentication token calculated by the receiver completable before actual transmission of the signals* as in claim 11. Further, the “Atalla” reference does not identically disclose Applicants respectfully disagree with the Office Action’s derived meanings of particular drawing references and discrete sections of the “Atalla” reference.

Accordingly, it is respectfully submitted that the “Atalla” reference does not identically disclose or even suggest the features of claim 11.

Since claims 12, 13, 15, 16, 18, 19, 22 and 23 depend from claim 11, those claims are allowable for at least the same reasons as claim 11.

Accordingly, Applicants respectfully submit that claims 11 to 13, 15, 16, 18, 19, 22, 23, 25, 27 and 29 are not identically described by the “Atalla” reference and withdrawal of the rejection of those claims is respectfully requested.

35 U.S.C. § 103(a) - Atalla reference and “Official Notices”

Claims 14, 17, 20, 21, 24, 26, 28 and 30, were rejected under 35 U.S.C. § 103(a) as obvious over the “Atalla” reference in view of the cited “Official Notices”.

Claims 14, 17, 20, and 21 depend from claim 11, and are therefore allowable for essentially the same reasons as claim 11, since the Official Notice does not cure the critical deficiencies of the “Atalla” reference.

Claims 24 and 30 are allowable for essentially the reasons explained above as to claim 11, since claims 24 and 30 include features like those of claim 11 as explained above, and since the “Official Notices” do not cure the critical deficiencies of the “Atalla” reference. Claims 26 and 28 depend from claim 24, and are therefore allowable for the same reasons as claim 24.

As further regards the obviousness rejections and the reliance on the Official Notices, Applicants respectfully traverse the Official Notices and/or the assertions of what was “well

known in the art” to the extent that they are maintained and requests that the Examiner provide specific evidence to establish those assertions and/or contentions that may be supported by such Official Notices and/or “well known in the art” assertions under 37 C.F.R. § 1.104(d)(2) or otherwise. In particular, it is respectfully requested that the Examiner provide an affidavit and/or that the Examiner provide published information concerning all such assertions. This is because the § 102 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also MPEP § 2144.03). The mere statements provided in the Office Action are not sufficient to show that the purported understanding (i.e., the Official Notices) is that which would have been had by one of ordinary skill in the art at the time of Applicants’ invention – which occurred more than 5 years ago.

As further regards the foregoing, judicial or official notice that is based on subjective and unsupported reasoning will not sustain an obviousness rejection. In the M.P.E.P. cited case of In re Ahlert, 165 U.S.P.Q. 418, 420-21 (C.C.P.A. 1970)), the Court made plain that:

Assertions of technical facts in areas of esoteric technology must always be supported by citation to some reference work recognized as standard in the pertinent art and the appellant given, in the Patent Office, the opportunity to challenge the correctness of the assertion or the notoriety or repute of the cited reference. **Allegations concerning specific “knowledge” of the prior art, which might be peculiar to a particular art should also be supported and the appellant similarly given the opportunity to make a challenge.**

In re Ahlert, 165 U.S.P.Q. at 420-21 (citations omitted).

Otherwise, if the Office cannot provide either references or an affidavit to support the assertions and/or contentions now made, including those made under Official Notice, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103 be withdrawn for this reason alone.

As further regard the obviousness rejections, to reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim element and it must also provide a motivation or suggestion for combining the elements in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

Further, conclusory statements cannot be relied upon in rejecting claims. In the case of In re Lee, 61 U.S.P.Q.2d 1430, 1433-35 (Fed. Cir. 2002), the Court reversed the Board of Appeals for relying on conclusory statements, stating the following:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory

*statements that “the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software” and that “another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial” do not adequately address the issue of motivation to combine. **This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.*** It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.

....

*In its decision on Lee's patent application, the Board rejected the need for “any specific hint or suggestion in a particular reference” to support the combination of the Nortrup and Thunderchopper references. **Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.***

*[The] “common knowledge and common sense” on which the Board relied in rejecting Lee's application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. **Conclusory statements such as those here provided do not fulfill the agency's obligation.***

[The] Board's findings must extend to all material facts and must be documented on the record, lest the “haze of so-called expertise” acquire insulation from accountability. “Common knowledge and common sense,” even if assumed to derive from the agency's expertise, do not substitute for authority when the law requires authority.

Thus, the proper evidence of obviousness must show why there is a suggestion to combine the reference and the “Official Notices” so as to provide the subject matter of the claims and its benefits.

The law mandates that the allocation of the proof burdens requires that the Patent Office provide the factual basis for rejecting a patent application under 35 U.S.C. § 103. (*See In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016, 154 U.S.P.Q. 173, 177 (C.C.P.A. 1967))). In short, the Examiner bears the initial burden of presenting a proper prima facie unpatentability case — which has not been met in the present case. (*See In re Oetiker*, 977 F.2d 1443, 1445, 24, U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992)).

Moreover, the combination of the "Atalla" reference and the Official Notice do not cover all of the features of the amended claims. As discussed above, the "Atalla" reference does not teach or describe calculating an authentication token *as a function of the data in the communication phase* to authenticate both the signals and transmission sequence of the signals, *wherein the signals received by the receiver from the transmitter are accepted as authentic if a transmitted authentication token that is received by the receiver matches the authentication token calculated by the receiver, the authentication token calculated by the receiver completable before actual transmission of the signals*, as in claim 14 (analogous to claims 24 and 30, and their dependent claims). Accordingly, Applicants respectfully submit that claims 14, 17, 20, 21, 24, 26, 28 and 30, are allowable over the cited reference(s), and withdrawal of the rejection of those claims is respectfully requested.

It is therefore respectfully submitted that claims 11 to 30 are allowable.

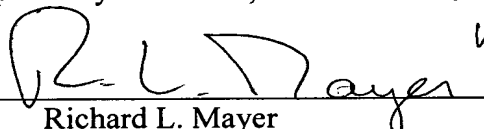
CONCLUSION

In view of the foregoing, it is believed that the rejections have been obviated, and that claims 11 to 30 are allowable. It is therefore respectfully requested that the rejections be withdrawn, and that the present application issue as early as possible. Should the Examiner wish to discuss this case, the Examiner is invited to contact the undersigned.


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